

III. Amendments to the Drawings:

New Fig. 12 has been added to include "a signature storage service apparatus 6." A page is attached as new Fig. 12.

IV. REMARKS

A. Status

Claims 1-23 are pending. Claims 5-9 and 20-23 are currently active for examination of which claims 5 and 20 are independent. Claims 1-4 and 10-19 stand withdrawn from consideration.

In the Office Action, the drawings were objected to under 37 C.F.R. § 1.83(a). *Id.* at 2-3. The specification was objected to because of the use of certain improper phrases. *Id.* at 3. Claims 5-9 were also objected for several informalities. *Id.* at 3-4. Claims 5-7 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP1094424 ("Miyazaki"). *Id.* at 5-8. Finally, claim 8 was rejected under 35 U.S.C. § 103(a) as being obvious over Miyazaki in view of U.S. Patent No. 7,162,635 ("Bisbee"). *Id.* at 7-9.

In this Amendment, the drawings are amended to overcome the objections. Amendment at 14. The specification has been amended to overcome the objections. *Id.* at 2. Claims 5, 7, and 8 have been amended and new claims 20-23 have been added to clarify an aspect of the invention. Care has been exercised not to introduce new matter.

B. Drawings Are In Compliance

The drawings were objected to because they fail to show "a signature storage service apparatus 6." Office Action at 2-3. In response, new Fig. 12 has been added to show that apparatus, but no new matter is introduced. Amendment at 14. Withdrawal of the objection is respectfully requested.

C. Claims Are Not Objectionable

Claims 5-9 objected to for various informalities. Office Action at 3-4. Claims 5-9 are hereby amended to incorporate the Examiner's suggestions and therefore Applicant respectfully requests withdrawal of the objections.

D. Claims Are Not Anticipated

Claims 5-7 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by Miyazaki et al. (EP Patent No. 1094424, hereinafter "Miyazaki"). The rejection is respectfully traversed for the following reasons.

1. Claims 5-9 Are Not Anticipated By Miyazaki

On one hand, independent claim 5 is amended to now include the following limitations:

- (a) a digital signature is "issued on a message by a digital signature issue side apparatus, in a signature history storage service apparatus...." Amendment at 6.
- (b) "registering a user of the signature history storage service apparatus who is a digital signer of the digital signature issue side apparatus..." *Id.* at 6.

On the other hand, Miyazaki discloses that a digital signature is generated in each digital signature side apparatus and stored in an external storage device 13 in the same of each digital signature side apparatus. Miyazaki at ¶ [0028]; [0144]. Thus, the above limitations of claim 5 are not met by Miyazaki. Thus, because Miyazaki does not teach each and every limitation of independent claim 5, there is no anticipation.

Of course, a dependent claim cannot be anticipated if the independent claim from which it depends is not anticipated. As discussed above, Applicant respectfully submits that claim 5 is

not anticipated. Claims 6-9 depend from claim 5. Therefore, claims 6-9 are also not anticipated.

2. New Claims 20-23 Would Not Be Anticipated By Miyazaki

Independent claim 20 is new and has not yet been examined. *Id.* at 11-13. However, Applicant respectfully submits that it is not anticipated by Miyazaki for similar reasons that independent claim 5 is not anticipated. Independent claim 20 includes a limitation such as (a) described above. Limitation (a), at least, is not met by Miyazaki, as previously discussed. Additionally, independent claim 20 includes a “deleting” step. Amendment at 11-12. This step is not taught by Miyazaki. As such, independent claim 20 would not be anticipated by Miyazaki.

Of course, a dependent claim cannot be anticipated if the independent claim from which it depends is not anticipated. As discussed above, Applicant respectfully submits that claim 20 would not be anticipated. Claims 21-23 depend from claim 20. Therefore, claims 21-23 would also not be anticipated.

E. Claims Are Not Obvious

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyazaki in view of Bisbee. Office Action at 7-9. The rejection is respectfully traversed.

Claim 8 is hereby amended to recite that, “transmitting the issued deposition request document electronic data, a public key certificate, and log list data, *to the signature history storage service apparatus...*” instead of *to* the log list storage side apparatus. Amendment at 7 (emphasis added). Similarly, the signature history storage service apparatus, not the log list storage side apparatus, verifies the validity of the received public log certificate and checks whether the deposition request document is verified correctly. *Id.* Hence, Bisbee does not teach

the amended limitation of claim 8, and therefore the cited prior art combination of Miyazaki and Bisbee cannot render claim 8 obvious.

V. **CONCLUSION**

In conclusion, Applicant respectfully submits that the claims are now in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



David A. Spenard
Registration No. 37,449

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 DAS:lcb
Facsimile: 202.756.8087
Date: July 6, 2007

Please recognize our Customer No. 20277
as our correspondence address.